

Serial No. 10/796,517

invention and Ming-Hui. Thus, it is respectfully submitted that Schremmer has deficiencies from the teachings of the present invention. Specifically, part 14 is specifically disclosed as holding an antenna 104, and there is no suggestion that it can receive the circuit board 100 in a manner as the present invention. Furthermore, front part 13 of Schremmer does not include two shells juxtaposed to each other, and likewise, rear end part 14 does not include first and second casings as recited in claim 1 of the present application. Furthermore, frame 13 (not part 14) includes the hooks and part 14 (not 13) includes the ears. There is no suggestion in Schremmer that part 14 could be made as two casings or that its structure could somehow be applicable to first and second casings such as present in Ming-Hui; that part 14 could receive a circuit board; that part 14 could include hooks and not ears; that part 13 could be made as two shells or that its structure could somehow be applicable to first and second shells such as present in Ming-Hui; or that part 13 could include ears and not hooks; and the like.

In the present rejection, the Examiner generally shows that hooks and ears are old and then indicates that it is obvious to substitute these features "for the purpose of facilitating assembly of the circuit card". However, the prior art does not suggest or provide a motivation to obtain such "an electronic card which facilitates assembly of the circuit card" as contended by the Examiner. Specifically, it should be appreciated that the reasons provided by the Examiner to show that the alleged modifications to Ming-Hui are based upon the hindsight knowledge of the present invention for the sole basis of attempting to meet the recitations of the claims. It is only after the present disclosure is known would one think to combine the certain aspects selected from the Ming Hui and Schremmer references. It is then submitted that such combination is improper because it requires considerable application of hindsight, hindsight that is gained only through applicant's disclosure. Specifically, the CAFC in Ecolochem Inc.v. Southern California Edison Co., 227 F.3d 1361, 56 USPQ2d 1065 (2000) stated:

Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability — the essence of hindsight." Id.

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re

Serial No. 10/796,517

Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). The same principle applies to invalidation. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although the suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness," Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting Lindemann, 730 F.2d at 1462, 221 USPQ at 488).

In this case, the district court used the '411 patent as a blueprint, with the Houghton process as the main structural diagram, and looked to other prior art for the elements present in the patent but missing from the Houghton process. The district court opinion does not discuss any specific evidence of motivation to combine, but only makes conclusory statements. "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

* * *

The absence of a convincing discussion of the specific sources of the motivation to combine the prior art references, particularly in light of the strength of prior art teaching away from the use of the Houghton process, is a critical omission in the district court's obviousness analysis, which mainly discusses the ways that the multiple prior art references can be combined to read on the claimed invention.

* * *

Because we do not discern any evidentiary basis for the finding by the district court that there was a suggestion, teaching, or motivation to combine the prior art references cited against the claimed invention, the district court's conclusion of obviousness cannot stand. The implicit generalized finding by the district court that, when one of ordinary skill in the art was faced with the problem of deoxygenating water for use in a nuclear power plant and the Houghton article, the combination claimed by Ecolochem in the '411 patent would have been obvious is insufficient. We have previously held that "[t]he suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the

Serial No. 10/796,517

nature of the problem to be solved.” WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). However, there still must be evidence that “a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” In re Rouffet, 149 F.3d at 1357, 47 USPQ2d at 1456; see also In re Werner Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[A] rejection cannot be predicated on the mere identification . . . of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”). Here, there was no such evidence presented.

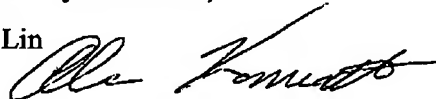
Turning to the present application, it is respectfully submitted that no evidence was given or exists why the elements would be selected from Schremmer for the combination in the manner claimed and which would support the broad conclusory statement “for the purpose of facilitating assembly of the circuit card” provided by the Examiner. Thus, it is respectfully submitted that the rejections have been overcome. Favorable reconsideration is respectfully requested.

The Examiner has cited the United States patents listed in NOTICE OF REFERENCES CITED as C-G of the Office Action dated August 25, 2005. By the lack of application of these references and others like them within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of these references.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicant’s electronic card which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 1-6 and 8-11 of the present application and to pass this application to issue.

Respectfully submitted,

Frank Lin



Dated: June 14, 2006.

Alan D. Kamrath, Reg. No. 28,227
NIKOLAI & MERSEREAU, P.A.
Attorneys for Applicant
900 Second Avenue South
Suite 820 International Centre
Minneapolis, MN 55402
Tel: (612) 392-7306
Fax: (612) 349-6556